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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/018,708	04/15/2002	Yuji Okuda	P3p2000078US/2369NP	1643
7590	09/22/2004		EXAMINER	
Sawyer Law Group PO Box 51418 Palo Alto, CA 94303			WILSON, LEE D	
			ART UNIT	PAPER NUMBER
			3723	
DATE MAILED: 09/22/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/018,708

Applicant(s)

OKUDA ET AL.

Examiner

LEE D WILSON

Art Unit

3723

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) 35-37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 10, 11 and 14-34 is/are rejected.
- 7) ☒ Claim(s) 5-9, 12 and 13 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>6/3/02</u> . | 6) <input type="checkbox"/> Other: ____. |

Election/Restrictions

1. Applicant's election without traverse of Group I, claims 1-34 in the reply filed on 6/7/04 is acknowledged.

Claim Objections

2. Claims 5-9 and 12-13 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claims. See MPEP § 608.01(n). Accordingly, the claims 5-9 and 12-13 not been further treated on the merits.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-4, 10-11, and 14-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tolles et al (6220942) in view of Cosmano et al (5454750).
 - a. Tolles et al disclose the claimed invention except for a ceramic or carbide ceramic.
 - b. Cosmano et al discloses a polishing system that uses a carbide ceramic or ceramic material which are use to form abrasive pads.
 - c. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the Tolles et al device by providing a material such as a ceramic or carbide ceramic as taught by Cosmano et al which are use to form abrasive pads.

d. Tolles et al discloses the claimed invention except for a ceramic or carbide ceramic material. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have used a ceramic or carbide ceramic material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

e. Tolles et al discloses the claimed invention except for grooves with depth range of $1/3$ to $1/2$ of thickness. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have grooves with depth range of $1/3$ to $1/2$ of thickness, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

f. Tolles et al discloses the claimed invention except for a young's modulus of each base being between 1.0 to 5.0kg/cm² ($\times 10$ to the sixth). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have a young's modulus of each base being between 1.0 to 5.0kg/cm² ($\times 10$ to the sixth), since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

g. Tolles et al discloses the claimed invention except for a thermal expansion coefficient of each base being in a range of 1.0×10 (to the sixth)/degrees and 8×10 (to the sixth) It would have been obvious to one having ordinary skill in the

art at the time the invention was made to have a thermal expansion coefficient of each base being in a range of 1.0×10^{-6} (to the sixth)/degrees and 8×10^{-6} (to the sixth), since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

h. Tolles et al discloses the claimed invention except for a brazing layer having titanium being a weight of .1 to 10 percent of the weight. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have a brazing layer having titanium being a weight of .1 to 10 percent of the weight since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

i. Tolles et al discloses the claimed invention except for an adhesive layer with a thickness of 10 to 50 micrometers. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have an adhesive layer with a thickness of 10 to 50 micrometers, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Nakata et al disclose a device.

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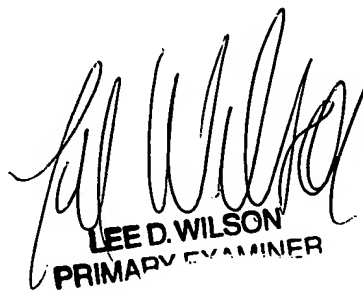
Any inquiry concerning this communication or earlier communications from the examiner should be directed to LEE D WILSON whose telephone number is 703-305-4094. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JOSEPH HAIL can be reached on 703-308-2687. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ldw

September 14, 2004



LEE D. WILSON
PRIMARY EXAMINER